

REMARKS

Restriction requirement

In the Office Action of August 9, 2005 the Examiner asserts, in a restriction requirement, that the present application contains claims directed to two distinct species, Species A (Figures 3A, 3B and 4) and Species B (Figure 5).

Applicant requests that the Examiner reconsider the requirement for restriction as discussed below.

1. The Examiner has issued a first Office Action on May 20, 2004 without a restriction requirement, and Applicant has replied to the first Office Action on August 20, 2004. The Examiner has issued a second Office Action on January 13, 2005 without a restriction requirement, and Applicant has replied to the second Office Action on April 13, 2005. Therefore, the Office Action of August 9, 2005 with a restriction requirement is the third Office Action issued by the Examiner. Applicant respectfully protests to this kind of piecemeal prosecution by the USPTO. Although 37 CFR 1.142(a) provides that restriction is proper at any stage of prosecution up to final action, according to MPEP 811 "before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required" (emphasis added). In the responses of August 20, 2004 and April 13, 2005, Applicant has not added new claims.

Therefore, there is no basis for the Examiner to assert it would be a serious burden not to require a restriction requirement after two Office Actions have already been issued and responded to. Should the Examiner disagree with the Applicant, the Examiner is respectfully requested to explicitly set forth the reasons why not issuing the current restriction would be a serious burden.

2. Further, while Applicant concurs with the Examiner's finding that Species A and Species B are patentably distinct, Applicant traverses the restriction requirement because the Examiner improperly issued the requirement. Group I and Group II are related because they each pertain to optical signal propagation. According to MPEP § 808.02, a restriction of distinct, but related inventions is proper only if the inventions are classified separately, have a separate status in the art, or require different fields of search. In the present case, there is no suggestion by the Examiner that Species A and Species B are

classified separately, have a separate status in the art, or require different fields of search. Because these conditions are not met and because the Examiner has already performed a search adequate for claims belonging to both Species A and Species B, the restriction requirement is improper and should be withdrawn.

3. In addition, 35 U.S.C. § 121 authorizes, but does not require, the USPTO to restrict an application to one invention if two or more independent and distinct inventions are claimed in one application. In view of the fact that the Examiner has already performed the search of all the claims and the expenses that would be imposed upon the Applicant by multiple patent applications and multiple patents, it is believed that restriction requirements should be issued only when absolutely necessary.

Therefore, Applicant submits that the restriction requirement set forth in the Office Action of August 9, 2005 is improper. As such, the Examiner is respectfully requested to withdraw the restriction requirement. However, as required under 35 USC § 121, the Applicant provisionally elects Species A (Figures 3A, 3B and 4). Claims 1-5, 7-53 and 68 read upon elected Species A.

Further, Applicant submits that, contrary to the Examiner's assertion, Claims 11, 37, 45 and 68 are generic claims that read upon both Species A and Species B. Therefore, those claims should not be withdrawn by the Examiner even in case the Examiner disagrees with Applicant's contentions above.

Additionally, Applicant expects the Examiner to use a consistent test with respect to what matters are obvious and what matters are unobvious throughout the prosecution of this application. Because the Examiner is adopting a particular standard for patentability in this case in terms of the election/restriction requirement, Applicant will expect that the same test be used throughout the prosecution of this application if the Examiner does not withdraw the election/restriction requirement made in the official action.

The traversal of the restriction requirement and the remarks regarding the traversal are being submitted without prejudice. Neither the traversal of the restriction requirement

nor the remarks regarding the traversal shall be interpreted as disputing the Examiner's finding that Species A and Species B are patentably distinct.

It is submitted that the application is in condition for allowance. Allowance of the application at an early date is solicited.

Conclusion

In view of the above, allowance of the pending claims is respectfully solicited.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

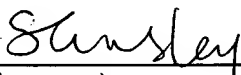
I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450 on

September 7, 2005

(Date of Deposit)

Shannon Tinsley

(Name of Person Signing)

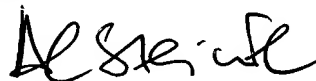


(Signature)

September 7, 2005

(Date)

Respectfully submitted,



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